

REMARKS/ARGUMENTS

The Office Action

Claims 17-20 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, and under 35 USC 103(a) as being unpatentable over Nakata in view of the prior art.

Rejections Under 35 U.S.C. 112, First Paragraph

The examiner asserts that claims 17-20 contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention. Applicants, however, disagree. One skilled in the art would be able to make and use the claimed invention using the application as a guide, as set forth below.

The third limitation of claims 17 and 19 includes "receiving user data concerning an output document, the user data comprising the number of images to be reproduced on the output document or the size of each image to be reproduced on the output document" (claim 17) and "a user interface operative to receive user data concerning an output document, the user data comprising the number of images to be reproduced on the output document or the size of each image to be reproduced on the output document" (claim 19). Despite the examiner's assertions to the contrary, the written specification does adequately teach the hardware elements and specific instructions for accomplishing these limitations. For example, the user interface of the printing system is described in detail on page 7 at lines 1-14. Likewise, the appropriate instructions are found on page 8 at lines 6-24.

Claim 17 includes "detecting the size of the input image automatically." However, the written specification is adequate to teach this feature. For example, on page 4, lines 4-6, it is noted that an additional feature includes "automatically detecting dimensions of the scanned image and automatically determining the predetermined number of repeated scanned images possible for printing out a single printing medium." This feature is further described on page 7, lines 16-23.

The fifth limitation of claim 17 and the fourth limitation of claim 19 relate to the feature of enlarging or reducing the input image automatically based upon the user data so that the input image may be reproduced in maximum number of times on the output document. This feature is described in detail on page 9 at lines 7-23. See also page 8,

lines 18-24. Thus, the user may select the number of reproductions of the input image.

Finally, there is adequate disclosure for the feature of reading an image document while preventing the reading of the white portions around the image. This feature is disclosed, for example, on page 5, lines 3-11, on page 7, lines 30-33, and on page 8, lines 26-34, to page 9, lines 1-5.

Rejections Under 35 U.S.C. 103(a)

Claims 17 and 19 call for scanning the input image but not scanning the weight space surrounding the image. The examiner acknowledges that this limitation is not taught or suggested by Nakata but claims that this feature "is well known in the art." The examiner has provided no reference or other evidence to support a conclusion that it would be obvious to one skilled in the art to produce the system and method of claims 17 and 19, aside from a conclusory statement that "it would have been obvious as a matter of design choice to combine the document detection means, discussed in the prior art, for reading the original without the white margins or null data for the purpose of accurately detection the size of an original." Applicant asserts that the examiner has impermissibly concluded that claims 17 and 19 are obvious in view of Nakata without any legitimate support in the record and respectfully requests, in accordance with the obligations imposed under MPEP §2144.03 (should a rejection of amended claims 17 and 19 be maintained), that the examiner provide a reference or other suitable evidence showing that one skilled in the art would be motivated to modify the teachings of Nakata as suggested.

As the examiner is aware, a prima facie case of obviousness is not established absent proper motivation. Simply because the document detection means of Nakata *could* be modified so as to scan only the image, a motivation to modify Nakata to meet the limitations of amended claim 17 and 19 is not formed. Moreover, according to MPEP §2144.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness." Merely because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See MPEP §2141.01 citing *Ex Parte Levingood*, 28 USPQ2d 1300 (Board of Patent Appeals and Interferences 1993).

Consequently, absent a motivation to combine and modify Nakata with the

feature of scanning the image while not scanning the white space surrounding the image, it is irrelevant that the elements and/or limitations may be individually or separate known in the prior art. Clearly, the examiner is motivated to combine these teachings for no other reason than to arrive at the claimed invention. This is a classic example of impermissible hindsight.

Accordingly, claim 17 and claim 18, which depends therefrom, and claim 19 and claim 20, which depends therefrom, are further patentably distinct over the references of record for the reasons discussed herein.

CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 17-20) are in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call John Zanghi, at Telephone Number (216) 861-5582.

Respectfully submitted,

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Date